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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,063	07/09/2004	Roland Schempp	3018	1612

7590 08/03/2006

Striker Striker & Stenby  
103 East Neck Road  
Huntington, NY 11743

EXAMINER

BARRERA, RAMON M

ART UNIT	PAPER NUMBER
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2832

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/501,063	SCHEMPP ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ramon M. Barrera	2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 8-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 7 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/9/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on 5/24/06 is acknowledged. The traversal is on the ground(s) that the claimed inventions possess unity of invention. This is not found persuasive because claim 1 (Group I) does not avoid the prior art and therefore lacks any special technical feature linking the inventions.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Brundage, cited on applicant's IDS.

Brundage discloses a hydraulic valve having a stroke limiter 92 and a nonmagnetic intermediary piece 24 thermally joined (brazed, col. 6, line 24) to a pole piece 26 and tubular piece 22 to form a sliding surface for armature 100.

5. Claims 1, 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelsey-Hayes, cited on applicant's IDS.

Kelsey-Hayes discloses a hydraulic valve having a stroke limiter (upper surface) 26 and a nonmagnetic intermediary piece 28 thermally joined (welded-p.5, lines 7-9) to a pole piece 30 and tubular piece 26 (side portion) to form a sliding surface for armature 32.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brundage.

Brundage failed to disclose the thermal joining being a capacitor discharge welding, nor the pole piece, intermediate piece, and the tubular piece being vertically aligned during the joining process, nor the stroke limiter is thermally joined to the tubular piece. It was commonly known to those of ordinary skill in the art that capacitor discharge welding could be substituted for brazing for the purpose of thermally joining metallic members. It was commonly known to those of ordinary skill in the art that structural elements could be vertically aligned before be joined for the purpose of enabling gravity assisted alignment of the elements. It was commonly known to those

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of ordinary skill in the art that metallic members can be fastened (col.8, lines 8-12) by a thermal joining process for the purpose of providing a closely abutting relationship.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ thermal joining by capacitor discharge welding, to vertically align the pole piece, intermediate piece, and the tubular piece during the joining process, and to thermally join the stroke limiter to the tubular piece for the purpose recognized in the art of Brundage, as discussed above.

8. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelsey-Hayes.

Kelsey-Hayes failed to disclose the thermal joining being a capacitor discharge welding, nor the pole piece, intermediate piece, and the tubular piece being vertically aligned during the joining process. It was commonly known to those of ordinary skill in the art that capacitor discharge welding could be substituted for friction or laser welding for the purpose of thermally joining metallic members. It was commonly known to those of ordinary skill in the art that structural elements could be vertically aligned before be joined for the purpose of enabling gravity assisted alignment of the elements. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ thermal joining by capacitor discharge welding and to vertically align the pole piece, intermediate piece, and the tubular piece during the joining process for the purpose recognized in the art of Kelsey-Hayes, as discussed above.

***Allowable Subject Matter***

9. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

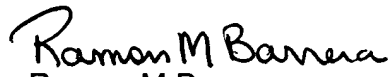
10. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art of record disclosed or reasonably suggested that the armature is introduced into the receptacle region before the pole piece, the intermediate piece, and the tubular piece are joined to one another.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramon M. Barrera whose telephone number is (571) 272-1987. The examiner can normally be reached on Monday through Friday from 11 to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Ramon M Barrera  
Primary Examiner  
Art Unit 2832

rmb